

NOV 20 2006

DOCKET NO. 01-S-017 (STMI01-00017)  
U.S. SERIAL NO. 09/943,815  
PATENT**REMARKS**

Claims 1-24 were pending in this application.

Claims 1-18 have been allowed.

Claims 19-24 have been rejected.

Claim 19 has been amended as shown above.

Claims 1-24 remain pending in this application.

Reconsideration and full allowance of Claims 1-24 are respectfully requested.

**I. ALLOWABLE CLAIMS**

The Applicant thanks the Examiner for the indication that Claims 1-18 have been allowed. These claims have not been amended and therefore remain in condition for allowance.

**II. REJECTION UNDER 35 U.S.C. § 101**

The Office Action rejects Claims 19-24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office Action asserts that these claims are directed towards a "recorded video product embodied on a computer readable storage medium" and that a "packet stored on a disk is not executed by a computer to perform specific functions to provide a practical application." (*Office Action, Page 2, Section 2*).

Claim 19 has been amended to recite that a "video playback device" uses data packets "in order to perform trick mode playback operations." Examiner Ahmad Matar indicated on November 16, 2006 that these amendments appear to overcome the § 101 rejection. However,

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Examiner Matar was not willing to state that Claim 19 is in condition for allowance since Examiner Matar had not reviewed the case.

The Applicant respectfully submits that Claim 19 is patentable. First, with the amendments to Claim 19, Claim 19 recites how the “data packets” can be used by a device to perform specific functions to provide a practical application.

Second, according to the Official Gazette notice dated November 22, 2005 and entitled “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” “functional descriptive material” includes data structures and computer programs that impart functionality when employed as a computer component. The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” In contrast, “nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

The subject matter recited in Claim 19 is not simply “nonfunctional descriptive material.” Claim 19 does not merely recite a “compilation or mere arrangement of data.” Rather, Claim 19 recites “data structures … that impart functionality when employed.” As noted above, Claim 19 has been amended to expressly recite that a “video playback device” uses the data packets “in order to perform trick mode playback operations.” As a result, the subject matter recited in Claim 19 is “functional descriptive material.”

According to the Official Gazette notice dated November 22, 2005, functional descriptive material that is recorded on some computer-readable medium becomes “structurally and functionally interrelated to the medium and will be statutory in most cases since use of

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technology permits the function of the descriptive material to be realized." Here, Claim 19 recites a product "embodied in a computer readable storage medium." As a result, Claim 19 recites functional descriptive material that is recorded on a computer-readable medium, which is statutory subject matter according to the Official Gazette notice.

The Office Action makes the assertion that a "recorded video product is protected under copyright law, not patent law." The Applicant respectfully notes that whether Claim 19 recites statutory subject matter requires an analysis of Claim 19 as a whole. (See, e.g., *11/22/05 Official Gazette notice; MPEP § 2106*). Claim 19 as a whole recites functional descriptive material "embodied in a computer readable storage medium." This is statutory subject matter according to the Official Gazette notice. Claim 19 does not become non-statutory simply because the preamble of Claim 19 uses the phrase "recorded video product."

For these reasons, Claims 19-24 recite patentable subject matter. Accordingly, the Applicant respectfully requests withdrawal of the § 101 rejection and full allowance of Claims 19-24.

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**SUMMARY**

The Applicant respectfully asserts that Claims 1-24 in this Application are in condition for allowance and respectfully requests full allowance of the claims.

If any outstanding issues remain, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@munckbutrus.com](mailto:wmunck@munckbutrus.com).

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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